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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,827	11/26/2003	Michael A. Kropp	57987US002	9277

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EXAMINER	
BERMAN, SUSAN W	

ART UNIT	PAPER NUMBER
1711	

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/723,827	**Applicant(s)** KROPP ET AL.	
	Examiner Susan W. Berman	**Art Unit** 1711	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: *16,17,19,21 and 23*.
   Claim(s) objected to: *11 and 12*.
   Claim(s) rejected: *1-10,12-15,18, 20, 22 and 24*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached pages.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Susan W Berman
Primary Examiner
Art Unit: 1711

Response to Proposed Amendment

The substitution of the definition of "polymer-bound" as set forth in the specification for the phrase "polymer-bound" in claim 1 clarifies the meaning of component "c" set forth in claim 1 and provides antecedent basis for the recitation of inorganic particles in claim 9. The proposed amendment does not clarify what is meant by the term "base" in claim 1 or the phrase "base unit" in claim 8. Applicant discusses suitable "basic species" in paragraph [0056] to [0057], such as different species of amines. The word "base" is not considered to have the same meaning as the phrase "basic species", such as an amine that has basic properties. The phrase "encapsulated base covalently bonded to a solid organic polymer or inorganic particles" as set forth in claim 1 encompasses (1) an encapsulated base of any known composition which "encapsulated base" is covalently bonded to...particles (2) a polymer based particle or an inorganic based particle which is encapsulated and (3) a component that is a basic species such as an amine covalently bonded to a polymer or to an inorganic particle and is encapsulated and (4) a component that is a basic species such as an amine that is encapsulated and covalently bonded to a polymer or to an inorganic particle. Claim 8 does not clarify the meaning of "encapsulated base" because B in the formula is defined as a "base unit" which fails to clearly define a "basic species", such as an amine that has basic properties.

Response to Arguments

Applicant argues that the encapsulated catalysts described by Spera et al either have no chemical bonding between the catalyst and the encapsulant or have ionic bonding between a nitrogen-containing catalyst and a microgel. This argument is not persuasive because the instant claims do not require covalent bonding between the encapsulant and the base that is covalently bonded to a polymeric or inorganic particle. The claims, as written, can be interpreted to set forth either a base covalently bonded to a solid organic polymer or inorganic particle that is encapsulated or an encapsulated base that is

covalently bonded to a solid organic polymer or inorganic particle. Spera et al disclose both catalysts that are not compounds not covalently bonded to a polymer or inorganic particle and catalysts that are covalently bonded to a polymer. Adducts of imidazoles with a bisphenol epoxy resin are taught in [0027]. An adduct of a polyamine with an epoxy resin in taught in [0028]. Phenolic curing agents that are bisphenol A endcapped with a diglycidyl ether of bisphenol A and phenol- or cresol-novolac curing agents are taught in [0029]. Each of these catalysts comprises an amine covalently bonded to an organic polymer. Spera et al further teach encapsulating the disclosed catalysts in [0037]. Spera et al teach that any of the disclosed amine-containing catalysts, including the covalently bonded catalysts discussed herein above, can be encapsulated in a microgel.

Applicant asserts that the onium salts comprising phosphorus, arsenic or nitrogen disclosed by Spera et al do not function as onium photoinitiators such as iodonium or sulfonium salt photoinitiators. However, applicant has not provided any evidence to support this assertion. Crivello (4,069,055) teaches Group V onium salts, including phosphonium borates, useful as photoinitiators for epoxy resins.

Applicant's arguments concerning the disclosure of Lamon et al are unpersuasive for the following reasons. Applicant claims a combination of a cationic photoinitiator and an "encapsulated base". Lamon et al teach using two or more of the disclosed catalysts in combination (column 13, lines 16-17, and lines 30-35). Furthermore, Lamon et al teach that preferred heat activated curatives exhibit latent thermal reactivity and are reactive at lower temperatures only after an activation step such as exposure to actinic radiation (column 13, lines 18-29). Thus, Lamon et al clearly teach the advantage of using radiation exposure with a latent thermal catalyst, thus suggesting combination of a cationic photoinitiator and a latent heat activated catalyst, such as an encapsulated catalyst.

Upon filing an Appeal, the indicated allowability of the subject matter of claims 11, 12, 16, 17, 19, 21 and 23 will be reconsidered in view of the disclosure of crystalline polymer imidazole used in the

Examples of Spera et al (see Table 1 and Table 3) and prior art that teaches side chain crystallizable polymers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W. Berman whose telephone number is 571 272 1067. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susan Berman

SB
3/9/06

Susan W Berman
Primary Examiner
Art Unit 1711